In THE UNITED STATES PATENT AND TRADEMARK OFFICE

Inventor: James J. Crow

Assignee: Motive, Inc.

Title: SYSTEM OF AUTOMATED CONFIGURATION OF NETWORK
                   SUBSCRIBERS FOR BROADBAND COMMUNICATION

Application No.:	09/653,486	Filing Date:	August 31, 2000
Examiner:	Uzma Alam	Group Art Unit:	2157
Docket No.:	MTV0017US	Confirmation No.:	4808

Austin, Texas
November 27, 2006

Mail Stop: Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

APPEAL BRIEF UNDER 37 C.F.R. § 1.191

Dear Sir/Madam:

This brief is submitted in support of the appeal filed August 15, 2006 by the Appellant to the Board of Patent Appeals and Interferences from the Examiner's final rejection of claims dated March 28, 2006.

Appellant filed a Pre-Appeal Request for Review on August 15, 2006. A Notice of Panel Decision from Pre-Appeal Brief Review was mailed September 25, 2006 indicating that Appellant should proceed to the Board of Patent Appeals and Interferences. The Notice gave Appellant until October 25, 2006 to file an appeal brief. Filed herewith is a Petition for Extension of Time requesting a one-month extension, thereby giving the undersigned a period until November 27, 2006 since November 25, 2006 falls on a Saturday.

Please charge deposit account No. 502306 for the fee of $500.00 associated with this appeal brief. Please charge this deposit account for any additional sums which may be required to be paid as part of this appeal.

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REAL PARTY IN INTEREST

The real party in interest on this appeal is Motive, Inc.

RELATED APPEALS AND INTERFERENCES

There are no appeals or interferences related to this application.

STATUS OF CLAIMS

The Final Office Action dated March 28, 2006 rejected claims 1-3, 7, 8, 9-13, 17-24 and 28-33 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,636,505 issued to Wang et al. ("Wang") and claims 4-6, 8, 14-16 and 25-27 under 35 U.S.C. § 103(a) as being unpatentable over Wang in view of U.S. Patent No. 6,684,242 issued to Bahlman et al. ("Bahlman").

STATUS OF AMENDMENTS

A Response to Final Office Action dated June 19, 2006 cancelled claims 21-29. Concurrently filed herewith is an amendment canceling claims 30-33. Appellant presumes these amendments are entered. As such, only claims 1-20 are pending.

SUMMARY OF CLAIMED SUBJECT MATTER

The invention is as set forth in the claims. To summarize the invention without intending to limit or otherwise affect the scope of the claims, the invention as set forth by independent claim 1 relates to a method. The method includes a determination as to whether the physical location of a personal computer 1 falls within a set of service boundaries for a broadband communication network 8. *See*, for example, Figs. 1 and 2, and; page 6: 5 - 11 and 17 - 24. If the physical rotation of the personal computer 1 falls within the service boundaries of the broadband communication network 8, then user access to the broadband communication network 8 is electronically offered. *See*, for example, Figs. 1 and 2; page 6: 17 - 24; page 6: 30 - page 7: 4, and; page 7: 24 - 26. An electronic order accepting the offer is received from a user. *See*, for example, page 8: 1 - 6. The personal computer 1 is remotely qualified for the broadband communication network 8 by determining whether the personal computer 1 meets

predetermined acceptance criteria for use of the broadband communication network **8**. *See*, for example, Figs. 1 and 2, and; page 8: 7 - page 9: 13. The order is fulfilled by initiating an automation agent **4** on the personal computer **1** to interact with the user and thereby configure a modem **3** or **11** coupled to the personal computer **1** for access to said broadband communication network **8**. *See*, for example, Figs. 1 and 2, and; page 8: 13 - 15. The order is further fulfilled by automatically configuring an asset of the broadband communication network **8** to communicate with the personal computer **1**, wherein said automatically configuring the asset is performed by an automation server **6** of the broadband communication network **8**. *See*, for example, Figs. 1 and 2, and; page 9: 31 - page 10: 2.

To summarize the invention without intending to limit or otherwise affect the scope of the claims, the invention as set forth by independent claim 11 relates to a system. The system includes an automation agent **4** residing on a personal computer **1**, and an automation server **6** remote from but in electrical communication with the personal computer **1**. *See*, for example, Figs. 1 and 2. The automation server **6** is configured to receive an electronic order from the personal computer **1**. *See*, for example, Figs. 1 and 2, and; page 8: 1 - 6. The automation server **6**, in response to receiving the order, remotely qualifies the personal computer **1** for broadband communication network 8 by determining whether the personal computer **1** meets predetermined acceptance criteria for use of the broadband communication network **8**. *See*, for example, Figs. 1 and 2, and; page 8: 7 - page 9: 13. The order is automatically fulfilled by initiating the automation agent **4** on the personal computer **1** to configure a modem **3** or **11** for access to the broadband communication network **8**. *See*, for example, Figs. 1 and 2, and; page 8: 13 - 15. The order is also fulfilled by configuring an asset of the broadband communication network **8** to interact with the personal computer **1**, wherein said automatically configuring the asset is performed by the automation server **6** of the broadband communication network **8**. *See*, for example, Figs. 1 and 2, and; page 9: 31 - page 10: 2.

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GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

I.   The rejection of claims 1 and 11 under 35 U.S.C § 102(e) as being unpatentable over Wang.

II.   The rejection of claim 4 and 14 under 35 U.S.C § 103(a) as being unpatentable over Wang and Bahlmann.

ARGUMENT

The Examiner rejected claims 1 and 11 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,636,505 issued to Wang. Appellant respectfully traverses the rejections.

Appellant's arguments of patentability are made primarily with respect to claim 1, which recites:

> 1. A method of converting a personal computer for communicating information on a broadband communication network, said personal computer having a user and a physical location, comprising:
> determining whether said physical location falls within a set of service boundaries for said broadband communication network;
> if said physical location falls within said service boundaries, electronically offering said user access to said broadband communication network;
> receiving from said user an electronic order accepting said offer;
> remotely qualifying said personal computer for said broadband communication network by determining whether said personal computer meets predetermined acceptance criteria for use of said broadband communication network; and
> fulfilling said order by
> initiating an automation agent on said personal computer to interact with the user and thereby configure a modem coupled to said personal computer for access to said broadband communication network, and
> automatically configuring an asset of said broadband communication network to communicate with said personal computer, wherein

said automatically configuring said asset is performed by an automation server of said broadband communication network.

Claim 1 recites **(1)** <u>initiating an automation agent</u> on said personal computer to interact with the user and thereby <u>configure a modem</u> coupled to said personal computer for access to said broadband communication network, and **(2)** <u>automatically configuring an asset of said broadband communication network</u>, wherein said automatically configuring said asset is performed by an <u>automation server</u> of said broadband communication network. The Examiner asserts column 5, line 20 – column 6, line 65 of Wang teaches **(1)** above. *See* Final Office Action dated March 28, 2006. The Examiner asserts column 6, line 38 and column 6, lines 46-49 of Wang teaches **(2)** above. *See* Advisory Action dated August 2, 2006. It is unclear from the Examiner's Final Office Action, the Advisory Acton, and the cited sections of Wang just what in Wang purportedly teaches limitations **(1)** and **(2)** above. The Appellant respectfully submits that nothing in the cited sections of Wang teaches or fairly suggests limitations **(1)** and **(2)** above.

Column 5, line 20 – column 6, line 65 of Wang, cited by the Examiner, fails to teach or fairly suggest **(1)** initiating an automation agent on said personal computer to interact with the user and thereby configure a modem coupled to said personal computer for access to said broadband communication network. Column 5, line 20 – column 6, line 65 of Wang describes automatically provisioning a modem of a personal computer in response to a user requesting service. Appellant has reviewed this cited section of Wang, and while this cited section teaches user interaction during the automatic provisioning of a modem, the cited section does not teach or fairly suggest initiating an agent on said personal computer as required by claim 1, let alone initiating an agent to interact with the user and thereby configure a modem. As such Appellant submits claim 1 is patentably distinguishable of the cited sections of Wang.

The Advisory Action dated August 2, 2006 asserts that column 6, line 38 and column 6, lines 46-49 of Wang teaches **(2),** automatically configuring an asset of said broadband communication network, wherein said automatically configuring said asset is

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performed by an automation server of said broadband communication network.
Column 6, line 38 and column 6, lines 46-49 of Wang recite, respectively:

> A preferred embodiment automates the service
> provisioning process...
>
> In accordance with a preferred embodiment of
> the present invention, an ILMI based automated service
> provisioning method is provided. The method will be
> described with reference to a user having an ADSL
> connection to the network service provider 30...

This foregoing sections of Wang is part of the overall section that teaches automatically provisioning a modem of a personal computer in response to a user requesting service. The foregoing sections of Wang do not teach automated service provisioning of an asset of the broadband communication network, let alone automated service provisioning by an automation server as required by claim 1. Indeed, it appears Wang teaches away from automated service provisioning of an asset of the broadband communication network. *See*, e.g., Figure 2 of Wang, which indicates an engineer (not an automation server) is responsible for manually configuring assets of a broadband communication network (i.e., network 60). As such, Appellant submits that claim 1 is patentably distinguishable over the cited sections of Wang.

On pages 8 and 9 of the Final Office Action, the Examiner asserts the limitation of automatically configuring an asset of a broadband communication network does not further limit the invention, since this asset can be any device on the network including the modem and the personal computer. However, this argument ignores the fact that claim 1 clearly distinguishes between a modem and a broadband asset. Specifically, claim 1 requires configuring (1) a modem, and (2) configuring an asset of said broadband communication network. Importantly, claim 1 recites configuring a modem *coupled* to said personal computer for access to the broadband communication network that contains the *asset*. In other words, the *modem* is configured to enable access to the broadband communication network that contains the *asset*. Claim 1 makes clear that the modem and the asset are separate entities since the asset is contained in the broadband communication network for which the modem is configured. Appellant responds that since the modem is configured for access to the broadband communication network that

contains the asset, automatically configuring the broadband asset does further limit the invention of claim 1.

Lastly, the Final Office Action on page 9 asserts that the rejection is modified to include specific portions of the Wang reference which also teach the update of the MIB (management information base) of the ATM. While Wang may teach updating the MIB, the Final Office Action does not assert that the MIB in Wang is updated automatically by an automation server of said broadband communication network, either alone or in combination with the remaining limitations of independent claim 1. For these reasons, Appellant asserts that independent claim 1 is patentably distinguishable over the cited sections of Wang.

Independent claim 11 recites limitations similar or identical to those of claim 1 described above. The Examiner rejected independent claim 11 for the same reasons the Examiner rejected claim 1. Because independent claim 11 contains limitations similar or identical to that argued above, Appellant submits that independent claim 11 is patentably distinguishable over the cited sections of Wang for the same or similar reasons claim 1 is patentably distinguishable over the cited sections of Wang.

The Examiner rejected claims 4 and 14 under 35 U.S.C. § 103(a) as being unpatentable over Wang in view of Bahlman Claims 4 and 14 depend from claims 1 and 11, respectively. Appellant traverses this rejection.

Claims 4 and 14 limit the broadband communication network of independent claims 1 and 11, respectively to a cable network. The Examiner admits in the Final Office Action that Wang does not teach the limitations of claims 4 and 14. However, the Examiner asserts Bahlmann teaches a cable network. The Examiner then asserts it would have been obvious to combine the cable network of Bahlmann with the broadband network of Wang, and a person or ordinary skill in the art would have been motivated to do this so that the network can be used with user premise equipment.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or

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in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success, must both be found in the prior art and not based on Applicant's disclosure. The initial burden is on the Examiner to provide some suggestion of the desirability of doing what the inventor has done. To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest that the claimed invention or the Examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references. *See* MPEP 2142.

Appellant submits that the Examiner has failed to provide a *prima facie* basis for rejecting claims 4 and 14. The teaching or suggestion to make the claimed combination and the reasonable expectation of success, must both be found in the prior art and not based on Applicant's disclosure. The Examiner cites nothing within Wang or Bahlmann which explicitly teaches or suggests their combination. Presumably, the Examiner relies on knowledge generally available to one of ordinary skill in the art, to combine Wang and Bahlmann. To support this conclusion the Examiner must present a <u>convincing</u> line of reasoning as to why the artisan would have found claims 4 and 14 to have been obvious in light of the teachings of Wang and/or Bahlmann. But, the Examiner does not present a convincing line of reasoning; the Examiner merely concludes one of ordinary skill would have been motivated to combine Wang and Bahlmann so that "the network can be used with user premise equipment." In addition, Wang teaches a method that enables a broadband communication network to be used with premise equipment. Specifically Wang teaches how to provision a modem of a personal computer for use with a broadband communication network. *See,* Wang column 5, line 20 – column 6, line 65. Because Wang teaches a method that enables premise equipment to be used with a broadband communication network, there is no need for one of ordinary skill to look to Bahlmann for a method that enables premise equipment to be used with a broadband communication network.

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MPEP 2142 is an objective standard that prevents examiners from picking and choosing ideas out of the prior art and simply lumping them together to re-create the invention at issue using hindsight. Appellant asserts the Examiner's rejection of claims 4 and 14 should be overturned as lacking a *prima facie* basis.

CONCLUSION

For the above reasons, Appellant respectfully submits that the rejection of pending Claims 1-20 is unfounded. Accordingly, Appellant respectfully requests that the Board reverse the rejections of these claims.

I hereby certify that this correspondence is being deposited with the United States Postal Service as First Class Mail in an envelope addressed to: Mail Stop Appeal Brief-Patents, Commissioner for Patents, P. O. Box 1450, Alexandria, Virginia, 22313-1450, on November 27, 2006.

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Respectfully submitted,

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APPENDIX

1.   (Previously Presented) A method of converting a personal computer for communicating information on a broadband communication network, said personal computer having a user and a physical location, comprising:

   determining whether said physical location falls within a set of service boundaries for said broadband communication network;

   if said physical location falls within said service boundaries, electronically offering said user access to said broadband communication network;

   receiving from said user an electronic order accepting said offer;

   remotely qualifying said personal computer for said broadband communication network by determining whether said personal computer meets predetermined acceptance criteria for use of said broadband communication network; and

   fulfilling said order by

   initiating an automation agent on said personal computer to interact with the user and thereby configure a modem coupled to said personal computer for access to said broadband communication network, and

   automatically configuring an asset of said broadband communication network to communicate with said personal computer, wherein said automatically configuring said asset is performed by an automation server of said broadband communication network.

2.   (Original) The conversion method of claim 1, wherein said broadband communication network is a DSL network.

3.   (Original) The conversion method of claim 2, wherein said qualifying step further comprises using a narrowband modem to contact a DSL line qualification server to test a physical line outside of said broadband communication network.

4.   (Original) The conversion method of claim 1, wherein said broadband communication network is a cable network.

5.   (Previously Presented) The conversion method of claim 4, wherein said qualifying step further comprises detecting a carrier signal from said broadband communication network.

6.   (Original) The conversion method of claim 5, wherein said carrier signal has a signal strength and a set of error codes, and wherein said qualifying step is based at least in part upon said signal strength and said error codes.

7.   (Original) The conversion method of claim 1, wherein said user is selected for said offer based on preestablished criteria.

8.   (Original) The conversion method of claim 6, wherein at least some of said criteria are stored in a subscriber profile database.

9.   (Original) The conversion method of claim 1, wherein said broadband communication network is an ISDN network.

10.   (Original) The conversion method of claim 1, wherein said broadband communication network is a wireless network.

11.   (Previously Presented) A system for configuring a personal computer for communicating over a broadband communication network, said system comprising:

    an automation agent software program residing on said personal computer; and

    an automation server remote from but in electrical communication with said

        personal computer, wherein said automation server is configured to

        receive from said personal computer an electronic order, in response to

        such order to remotely qualify said personal computer for said broadband

        communication network by determining whether said personal computer

        meets predetermined acceptance criteria for use of said broadband

        communication network; and to automatically fulfill said order by

initiating said automation agent on said personal computer to configure a modem coupled to said personal computer for access to said broadband communication network and automatically configuring an asset of said broadband communication network to interact with said personal computer wherein said automatically configuring said asset is performed by an automation server of said broadband communication network.

12.   (Original) The configuration system of claim 11, wherein said broadband communication network is a DSL network.

13.   (Original) The configuration system of claim 12, wherein said automation agent instantiates a narrowband modem to contact a DSL line qualification server to test a physical line.

14.   (Original) The configuration system of claim 11, wherein said broadband communication network is a cable network.

15.   (Original) The configuration system of claim 14, wherein said automation agent instantiates detection of a carrier signal from said broadband communication network.

16.   (Original) The configuration system of claim 15, wherein said carrier signal has a signal strength and a set of error codes, and wherein said signal strength and said error codes are used by said automation agent when qualifying said personal computer.

17.   (Original) The configuration system of claim 11, wherein said user is selected for said offer based on preestablished criteria.

18. (Original) The configuration system of claim 17, wherein at least some of said criteria are stored in a subscriber profile database.

19. (Original) The configuration system of claim 11, wherein said broadband communication network is an ISDN network.

20. (Original) The configuration system of claim 11, wherein said broadband communication network is a wireless network.

21. – 33. (Cancelled)

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EVIDENCE APPENDIX

None

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RELATED PROCEEDINGS APPENDIX

None